REMARKS

Applicant respectfully requests reconsideration and continued examination of this application, particularly in view of the following remarks. Claims 1-42 are pending in this application.

I. Prior Art Rejections

Claims 1-2, 5-8, 10-17, 20-22, 24-28 and 42 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,326,032 to Richter et al. (Richter) in view of U.S. Patent No. 5,368,828 to Carlson (Carlson) and further in view of U.S. Patent No. 4,635,662 to Totten (Totten). Claims 3-4, 9, 18-19, and 23 were rejected under 35 U.S.C. § 103(a) as being obvious over Richter in view of Carlson, and further in view of Totten and U.S. Patent No. 4,566,251 to Spisak (Spisak). Claims 29-40 were rejected under 35 U.S.C. § 103(a) as being obvious over Richter in view of Carlson and in further view of Spisak. Claim 41 was rejected under 35 U.S.C. § 103(a) as being obvious over Richter, in view of Carlson, and further in view of Spisak and Totten. Applicant respectfully traverses the rejections for the reasons set forth below. Clearly, the *John Deere* factors have not been met for a finding of obviousness.

II. Rejection of Claims 1-2, 5-8, 10-17, 20-22, 24-28 and 42

Claims 1-2, 5-8, 10-17, 20-22, 24-28 and 42 were rejected under 35 U.S.C. § 103(a) as being obvious over a combination of three disparate references, U.S. Patent No. 6,326,032 to Richter et al. (Richter) in view of U.S. Patent No. 5,368,828 to Carlson (Carlson) and further in view of U.S. Patent No. 4,635,662 to Totten (Totten).

The Examiner admits that Richter does not teach any of the following: (1) an atomized sterilant; (2) a structure for introducing a sterilant into a bottle while the bottle is inverted from a location exterior to the opening of the bottle; and (3) a structure for maintaining the sterilant on the bottle while the bottle is inverted. The Examiner contends, without any suggestion for such a combination in any of the references themselves, that the unrelated Carlson and Totten references provide

these deficiencies in Richter by way of Carlson's disclosure of introducing an atomized sterilant on the interior side walls and bottom of a carton and Totten's disclosure of introducing a water rinse into an inverted bottle from a location exterior the inverted bottle. Thus, the Examiner concludes that one of ordinary skill in the art would have been motivated, again without any suggestion from the references themselves, to modify Richter's method and apparatus to include a bottle inversion step in order to flush the entire bottle of any foreign matter which inadvertently previously found its way into the bottle.

Applicant respectfully traverses the rejections for the following reasons and other reasons that will be apparent. Richter does not even remotely suggest introducing an atomized sterilant into an inverted bottle. Nor does Richter have any disclosure as to bottle shape, which the Examiner implicitly admits as the Examiner states it is "inherent." *See*, March 2, 2004 Office Action at pp. 2-3. The Examiner attempts to fill in those deficiencies with the combination of Carlson and Totten. However, Carlson only teaches introducing an atomized sterilant into a rectangular-shaped carton in a cone-shaped spray pattern from a position above the carton. Carlson at col. 3, lines 17-20. Thus, not only does Carlson fail to teach introducing an atomized sterilent into an inverted bottle, but clearly teaches away from the present invention. Teaching away is a *per se* demonstration of a lack of prima facie obviousness. *In re Dow Chemical.*, 837 F.2d 469 (Fed. Cir. 1988). The Examiner cites Totten for its teaching of rinsing a bottle with a high volume water rinse while the bottle is inverted. However, there is no teaching in Totten which would suggest to one skilled in the art that an atomized sterilant could be introduced into an inverted bottle as Totten only introduces a high volume rinse into the bottle. Accordingly, there is no teaching or suggestion whatsoever in Richter, Carlson or Totten that would lead one skilled in the art to introduce an atomized sterilant into an inverted bottle. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one skilled in the art." *See* MPEP 2143. Furthermore, there is also absolutely no teaching or suggestion to modify the cone-shaped spray that covers the interior surfaces by

direct impingement in Carlson with the use of Applicant's invention, which does not require direct impingement or a "line of sight spray" to cover all of the interior surfaces. Moreover, the Examiner has not provided any explanation for modifying any of the references to arrive at the present invention.

Additionally, one skilled in the art could not combine the teachings of Richter, Carlson and Totten as described above to arrive at the claimed invention without using the present application as a roadmap. To do so, as the Examiner has done is improper hindsighted reasoning. The use of the present application in such a manner cannot be the basis of an obviousness rejection. Thus, in view of the above, claims 1-2, 5-8, 10-17, 20-22, 24-28 and 42 are not obvious over Richter in view of Carlson and further in view of Totten.

III. Rejection of Claims 3-4, 9, 18-19, and 23

The same combination of Richter, Carlson, and Totten were again cited by the Examiner to reject claims 3-4, 9, 18-19, and 23. As discussed above, there is no motivation or suggestion whatsoever in the cited references to combine the references, thus, any combination thereof is based on an improper hindsighted reconstruction of the claimed invention. The only way one would arrive at the present invention from the teachings of Richter, Carlson, and Totten is to erroneously use the present application as a roadmap. Thus, for these reasons alone, the rejection of claims 3-4, 9, 18-19, and 23 is improper, and thus those claims are not obvious in view of the cited prior art.

Moreover, in rejecting claims 3-4, 9, 18-19, and 23, the Examiner added a fourth reference, Spisak, for its teaching of introducing hydrogen peroxide in the form of a fog in such a way as to promote condensation on all surfaces of a carton. Spisak, however, further teaches away from the combination of Richter, Carlson, Totten, and Spisak. Spisak teaches a carton, forming, sterilizing, filling, and sealing machine wherein a sterilant vapor is introduced into each open-topped container when the containers are in an upright position. *See* Abstract and Claim 1 of Spisak. The containers are then rotated from an upright position to an upside down position and through a heated and air blown atmosphere and back to an upright position onto a conveyor means. Spisak is wholly silent as to introducing a sterilizing agent, such

as a supersaturated fog, to promote condensation of the particles on the bottle surface into an inverted bottle. Accordingly, Spisak provides no further teaching that would fill in the deficiencies of Richter, Carlson, and Spisak and which would lead one skilled in the art to introduce an atomized sterilant into an inverted bottle.

IV. Rejection of Claims 29-40

Additionally, the Examiner rejected claims 29-40 under 35 U.S.C. § 103(a) as being obvious over Richter in view of Carlson and further in view of Spisak. The Examiner admits that Richter fails to disclose a nozzle disposed under and exterior to the opening of a bottle. However, the Examiner contends that Spisak discloses the concept of inverting open top containers on a conveyor to drain the sterilant and that while the sterilant is drained, an exterior nozzle 114, FIG.3 is disposed under the open top containers.

Applicant submits claims 29-40 are not obvious over Richter in view of Carlson, and further in view of Spisak for the reasons set forth above. Richter does not even remotely suggest introducing an atomized sterilant into an inverted bottle. Carlson only teaches introducing an atomized sterilant into a rectangular-shaped carton from a position above the carton and in a cone-shaped spray pattern, utilizing direct impingement, in order to cover the interior surfaces. Moreover, Spisak only teaches introducing a sterilant vapor into the top of a container. Thus, the Examiner has not offered any evidence, nor is there any suggestion from the references, which would suggest why from Richter's, Carlson's, or Spisak's teachings, one skilled in the art would be motivated to introduce the atomized sterilant in an inverted position and still obtain a thin coat of sterilant on the interior surface of the bottle.

Additionally, claims 29-40 require that the nozzle disposed under and exterior to the opening of a bottle be of such a structure as to introduce a sterilizing agent in the form of atomized particles onto the interior surface of the bottle while the bottle is in an inverted position. The Examiner contends that Spisak discloses an exterior nozzle 114, FIG. 3 which is disposed under the open top containers when the sterilant is drained. Applicant fully disagrees with this interpretation of Spisak. In contrast, the description of FIG. 3 within the specification discloses that the nozzle 114 is a "suitable nozzle inlet means...aimed generally at the open tops of the first

pair of cartons..." Spisak, col. 5, lines 11-28. Thus, Spisak does not teach or remotely suggest a nozzle disposed under and exterior to the opening of a bottle be of such a structure as to introduce a sterilizing agent in the form of atomized particles onto the interior surface of the bottle while the bottle is in an inverted position.

V. Claims 1-40 Are Patentable for Additional Reasons.

Claims 1-40 are also patentable over the cited prior art because none of the cited references teach or suggest an inverted bottle having an opening which is smaller in width than the width of the body portion to prevent introduction of particles from a source located exteriorly of the bottle from impinging directly on a portion of a bottle surface.

Additionally, claims 1-40 are patentable over any of the references cited against claims 1-40 because claims 1-40 all require an inverted bottle having an opening which is smaller in width than the width of the body portion to prevent introduction of particles from a source located exteriorly of the bottle from impinging directly on a portion of a bottle surface. The Examiner contends the inherent structure of the bottles in Totten in view of Carlson's teaching of introducing atomized particles results in preventing atomized particles from impinging directly on a portion of a bottle surface. Applicant respectfully disagrees with the Examiner's position. Neither Carlson nor Totten has any disclosure whatsoever of a bottle having an opening which is smaller in width than the width of the body portion. Carlson merely discloses cartons having a rectangular structure and specifically uses a cone-shaped spray in order to cover the interior surfaces by direct impingement. Carlson at col. 3, lines 17-20. Totten only discloses that the apparatus is adapted for bottles of different sizes. Totten col. 11, lines 11-15. In particular, Totten only discloses varying the bottle's carrying structure of the system based on the height or diameter of the bottles. Totten, col. 3, line 46 to col. 4, line 46. Thus, the Examiner appears to be reading into the references what is not disclosed, which is an improper basis for rejecting a claim. Moreover, that which is inherent is not necessarily known – obviousness cannot be predicated on that which is inherent but not known. The Examiner has not provided the requisite evidence to

provide a basis in fact that the alleged inherent characteristics flow from the teachings of Totten and Carlson.

VI. Claim 41 Rejection

Lastly, the Examiner rejected the newly added claim 41. Claim 41 was rejected under 35 U.S.C. § 103(a) as being obvious over Richter, in view of Carlson, further in view of Spisak and Totten. Richter fails to teach a nozzle disposed under and exterior to the opening of a bottle and contacting the bottle interior with a sterilant while the bottle is inverted. Carlson fails to teach inverting bottles, disposing a nozzle under the exterior of the opening of a bottle and contacting the bottle interior with a sterilant while the bottle is inverted and using other than direct impingement for surface contact. However, the Examiner contends Spisak and Totten fill in the deficiencies of Richter and Carlson. In particular, the Examiner contends Spisak discloses inverting open top containers to drain sterilant such that an exterior nozzle is disposed under the open top containers and that Totten teaches contacting the bottle interior with a sterilant while the bottle is inverted.

Applicant traverses the rejection of claim 41 for the reasons previously discussed. For example, Richter does not even remotely suggest introducing an atomized sterilant into an inverted bottle. The Examiner attempts to fill in this deficiency with the combination of Carlson, Spisak, and Totten. However, Carlson merely teaches introducing an atomized sterilant into a rectangular-shaped carton from a position above the carton and in a direct impingement cone-shaped pattern. Similarly, Spisak only teaches introducing a sterilant vapor into an upright carton. The Examiner cites Totten for its teaching of rinsing a bottle with a high volume water rinse while the bottle is inverted. Thus, there is no reference that suggests to one skilled in the art the introduction of an atomized sterilant into an inverted bottle. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one skilled in the art." *See* MPEP 2143. Hence, there clearly is no such motivation or suggestion. This rejection, like the others, is only a combination of four disparate references combined

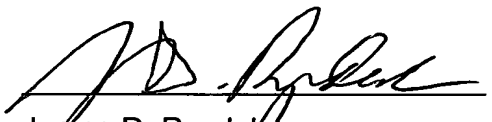
using the present invention as a list from which to pick and choose certain elements from the references, while at the same time rejecting those elements from the references that are not found in the list.

Further, as discussed previously, claim 41 similarly requires a nozzle disposed under and exterior to the opening of a bottle. Spisak merely teaches a nozzle 114 which is "suitable nozzle inlet means...aimed generally at the open tops of the first pair of cartons..." Spisak, col. 5, lines 11-28. Thus, Spisak does not teach or remotely suggest a nozzle disposed under and exterior to the opening of a bottle which can introduce a sterilizing agent in the form of atomized particles onto the interior surface of the bottle while the bottle is in an inverted position.

CONCLUSION

In conclusion, pending claims 1-42 are allowable and an early indication of allowance is solicited.

Respectfully submitted,



James D. Ryndak
Registration No. 28,754
Attorney for Applicant

Dated: June 2, 2004

RYNDAK & SURI
30 North LaSalle Street
Suite 2630
Chicago, IL 60602
(312) 214-7770